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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/630,509   | 07/30/2003  | Kazunori Taniguchi   | P/3541-38           | 7893             |
| 2352 7590 10/30/2008<br>OSTROLENK FABER GERB & SOFFEN<br>1180 AVENUE OF THE AMERICAS<br>NEW YORK, NY 100368403 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| NGUYEN, TUAN VAN   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3731   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/630,509

**Applicant(s)**

TANIGUCHI ET AL.

**Examiner**

TUAN V. NGUYEN

**Art Unit**

3731

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9, 26, 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 11, 15-25, 27-34 and 38 is/are rejected.
- 7) ☒ Claim(s) 12-14, 36 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-38 are pending in this present application.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2008 has been entered.

#### ***Response to Amendment***

3. Applicant's arguments filed on August 13, 2008 with respect to that Sasaki fails to teach the new limitation of " wherein when the insertion section and the support are arranged on the same axis, an end surface in an axial direction of the connecting rod is inclined in an axial direction of the insertion section and the support." in independent claims 1, 33 and 38 has been fully considered and persuasive. However, upon further search and consideration claims 1, 33 and 38 are rejected in view of new ground of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. **Claims 1, 2, 10-11, 15, 16, 23-25, and 38 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Sasaki (U.S. 2002/0055758).**
7. Sasaki discloses (Figs. 1-7B) a surgical instrument 1 comprising, among other things:
  - a. an insertion section 2 having a treatment section 3 or distal end portion 3 and a proximal end portion that coupling to handle 39 and 37, the insertion section comprising first driving rod 5 to open and close a pair of jaws 12, 14 disposed in the distal end portion of the insertion section 2 and second and third driving rod 5 and 7, respectively (Fig. 2A and [0039]-[0041]);

- b. a support 21 (Figs. 2A and 4 ) which pivotally supports jaw 14 of the pair of jaws 12, 14 to be relatively opened/closed ([0044]) and the insertion section 2 and support 21 are arranged on a same axis (Fig. 1D);
- c. a first coupling member 16 or sliding member 16, which connected to connecting rod 18 connecting member, for providing axial movement and support jaw 12, wherein the sliding member being pivotally supported on the distal end portion of the connecting rod 18 (Figs. 3A-3B), noting that the sliding member also positioned on a center axis of support 21 (Fig. 2E and 4);
- d. a connecting rod 18 having a distal end portion and a proximal end portion, the sliding member being pivotally supported on the distal end portion of the connecting rod to open/close the pair of jaws, and the distal end portion of the first driving rod 5 being pivotally supported on the proximal end portion of the connecting rod 18;
- e. a rotation mechanism that includes second driving rod 6 and third driving rod 7(Figs. 5A-7B), which rotatably supports the support 21 on the distal end portion of the insertion section 2, and pivotally supports the support 21 (Fig. 4) in a state of being offset with respect to a center axis of the support (Fig. 2A and Fig. E);
- f. and handles 39 and 37 or an operation section disposed in the proximal end portion of the insertion section 2, which pivotally supports the proximal end portions of the first, second and third driving rods, when the operation

section is opened/closed and rotated to slide the first driving rod 5 to slide the sliding member 16 through the connecting rod 18 thereby opening/closing the pair of jaws 12, 14 and a rotating force by the rotation operation being transmitted from the proximal end portion to the distal end portion of the second driving rod 6 and third driving rod 7 to apply a rotational force on the support to rotate the support 21 on the distal end portion of the insertion section, thereby rotating the pair of jaws with respect to the insertion section relatively (Figs. 4 and 5A-7B and [0055]-[0075]).

8. Sasaki discloses the invention substantially as claimed except for the new limitation of "an end surface in an axial direction of the connecting rod is inclined in an axial direction of the insertion section and the support". However, it would have been obvious to one of ordinary skill in the art to provide an inclined end surface similar (Fig. 3A, end surface near pin 15) of component 16 to the end surface of connecting rod 18 to prevent jamming and to provide a atraumatic end surface to prevent damage to the tissue.
9. Referring to **claim 11**, Sasaki discloses (Fig. 2A) first coupling member 16 or sliding member includes a hole for engaging with pin 17 of connecting rod 18. Noting that the hole has a circular-arc surface and the pin, which is an integral part of connecting rod, has an outer surface that is abutted on the circular-arc surface of the hole. Thus, Sasaki discloses the connecting rod has an abutment surface which is abutted on the circular-arc surface of the sliding member 16.

10. Referring to **claim 25**, Sasaki discloses (Figs. 5A-7B) the operation section includes rotary handle has a first operation section connecting rod 43, which connected to a proximal end of a second operation section connecting rod 41, wherein the distal end of the second connecting rod 41 connected to the proximal end portion of first driving rod 5.
11. **Claims 3-5, 17-22, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki (U.S. 2002/0055758) in view of Klieman et al (U.S. 5,827,323).**
12. Sasaki discloses the invention substantially as claimed except for the connecting rod is made of stainless steel, pair of jaw, the sliding members has conductivity and a connector pin which supplies high-frequency power is electrically connected to at least one of the first driving rod, the connecting rod, the sliding member and the pair of jaw. However, Klieman discloses (see Figs. 6 and 7) a endoscopic surgical tool can be connected to energy supply via connecting pin 14 which supply energy to driving rod 32 for performing electrocautery (col. 10, lines 35-68). Klieman also disclosed (Fig. 6) tubular barrel 10 having a bevel shape 23 for preventing the proximal portion of the jaw 33, 35 from engaging tissue during a surgical procedure (col. 5, lines 55-56 and col. 7, lines 60-68) and tubular barrel is fabricated from plastic (col. 5, lines 60-65). It would have been obvious to one of ordinary skill in the art modified the device of Sasaki so that it too would have the advantage of providing electrocautery ability to the surgeon.

***Allowable Subject Matter***

13. Claims 6-9, 26, 34 and 35 are allowable over prior art of record.
14. Claims 12-14, 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Art Unit: 3731

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731